

Remarks

Applicants have neither amended nor canceled claims in this Response. Accordingly, claims 38 to 43, and 45 to 56 remain pending in this patent application. Applicants now address each and every point noted in above-identified Office action as follows:

I. Rejection of Claims

Claims 43, 46 to 48, and 50 to 56 under 35 U.S.C. § 103 as being allegedly unpatentable over Samonides in view of McNaul. The Applicants now address the points raised by the Examiner in the context of the two pending and rejected independent claims, i.e., 43 and 46 below:

A. Independent claim 43

This claim relates to a method for forming a pressure-sensitive adhesive (PSA) construction having the basic structural elements comprising: (1) a PSA material disposed onto a release surface of a removable substrate; (2) a film-forming material disposed onto a surface of the PSA to form a continuous film thereover; (3) an overlamine film layer disposed onto the continuous film; and (4) a printed indicia interposed between overlamine film layer and the continuous film.

The claimed method involves the steps of: (1) applying the PSA material to the release surface of the removable substrate; (2) applying the film-forming material onto a surface of the PSA material, while the pressure-sensitive adhesive material is in a non-final state, to form the continuous film thereover and render the PSA tack free; (3) laminating the overlamine film layer onto the continuous film; and (4) forming the printed indicia onto one of the continuous film or a backside surface of the overlamine film layer adjacent the continuous film.

An above-identified feature of this claimed method is that the film-forming material is applied to a surface of the PSA while the PSA is in a non-final state. The terms "non-final state" as used in this claim are understood to mean that the PSA material is not in a final or fully

developed/fully matured state, i.e., the PSA material is at a state where it does not yet display the desired final performance properties useful in the completed PSA construction.

In the Office action, the Examiner states that the Applicants argued that the non-final state of the PSA related to the point in time that the PSA material itself was being applied to the removable substrate. This is incorrect. Applicants' statement (made on page 8, second full paragraph, of its earlier Amendment) related to what Samonides disclosed. In its earlier Office action, the Examiner argued that Samonides disclosed that the PSA was "very close to its final form" at the time that it was applied. Applicants were only agreeing with this point by stating that its claimed invention was distinguishable from Samonides because it recited the feature that the PSA is at a non-final state when the film forming material is applied to it.

Applicants hope that this point is clear. Applicants do not dispute that Samonides discloses the concept of applying a PSA when it is not yet in final state. However, from this it does not necessarily follow that the PSA is still in a non-final form when any subsequent printed indicia is applied to the PSA or any protective layer is deposited over the printed indicia and/or PSA. In fact, as discussed below, Samonides clarifies this point by stating that after the PSA layer is applied, and prior to any printing, it is dried to a final moisture content. Therefore, Applicants submit that Samonides clearly does not disclose or remotely suggest the concept of applying a subsequent layer to the PSA when the PSA is in a non-final state, as recited in Applicants' claim 43.

Applicants now summarize the teaching of Samonides as disclosing a PSA-backed substrate having the basic structural construction of: (1) a release coated carrier; (2) a PSA material deposited on the carrier; (3) a printed indicia applied to a portion of the PSA material; and (4) a protective layer deposited over the printed indicia and a portion of the remaining exposed surface of the PSA material.

A first critical shortcoming of Samonides is that it fails to disclose or even remotely suggest a PSA construction comprising the further construction element of a continuous film interposed between the PSA and the printed indicia. This was in fact admitted by the Examiner in the Office action dated April 5, 2002, and has again been reaffirmed by the Examiner in this Office

action. Accordingly, Samonides fails to disclose or suggest a method that involves applying a film-forming material onto the PSA as recited in claim 43.

A second critical shortcoming of Samonides was discussed above; namely, that it fails to disclose or even remotely suggest a method that includes the recited claim step of applying a film-forming material onto the PSA layer while the PSA is in a non-final state.

These two shortcomings are significant, as one having ordinary skill in the art would not learn and/or be motivated by Samonides to prepare a PSA construction either having a continuous film interposed between the PSA and an overlamine layer, or applying the film-forming material when the PSA material was in a non-final state.

In the Office action, the Examiner comments on the Applicants' analysis of the cited prior art as being a "piece-meal analysis of the references." Applicants wish to clarify that while its earlier remarks had indeed addressed the shortcomings of the two cited references separately, this was done for the purpose of clearly setting forth those invention features that each reference could arguably support. This separate analysis supplemented and did not supplant Applicants' analysis of the references taken in combination, as the Applicants' analysis and position based on the combination of the two references was clearly provided in its earlier remarks (page 9, third full paragraph).

Applicants now again summarize the teaching of McNaul as disclosing a printable laminate construction comprising: (1) a release liner; (2) a PSA material disposed on the release liner; (3) a layer of vinyl film on the PSA material; (3) a printed indicia on the vinyl film surface; and (4) a protective overcoating on the printed indicia. The Examiner argues that McNaul teaches the use of a vinyl film material over the PSA material, printing on the vinyl film surface, and placing a protective overcoating on the printed indicia. Applicants do not dispute this.

However, McNaul fails to disclose or remotely suggest how its constructions are made and, more specifically, fails to disclose the specific state of the PSA material at the time that the vinyl film is applied, i.e., is it fully cured or in a non-final state.

The invention constructions disclosed in McNaul are fundamentally different from that recited in Applicants' claim in that they are made from an assembly of preformed elements, e.g., a preformed carrier tape and application tape. Since McNaul discloses the use of preformed elements, it is necessarily completely silent with respect to the specific concepts and methods of fabrication that could possibly involve forming a protective film layer over the PSA layer at any point when the PSA layer is other than in a finished and completely developed state, i.e., is in the form of a completed assembly element. This shortcoming is significant, as one skilled in the art would only learn and/or be motivated from McNeal to use preformed elements, rather than learning a process of making a PSA construction involving forming the construction from raw materials.

Now knowing the shortcomings of each cited reference, the combination of the two references is now evaluated. As noted above, neither Samonides nor McNaul disclose or remotely suggest the method step recited in claim 43 of applying the film-forming material at a point when the PSA material is in a non-final state. Since neither reference alone discloses or suggests this concept, the combination of both references cannot operate to magically teach or motivate one skilled in the art to do what is missing in each. Thus, Applicants submit that from the combination of Samonides and McNaul one having ordinary skill in the art would not learn and/or be motivated to make a PSA construction according to Applicants' claim method that includes the step of applying a film-forming material at a point when the PSA material is in a non-final state.

Therefore, Applicants submit that its invention as recited in independent claim 43 is not obvious over the combined teachings of Samonides and McNaul, and for this reason respectfully request that the rejection of independent claim 43 under 35 U.S.C. §103 be reconsidered and withdrawn.

B. Independent Claim 46

This claim recites a method for forming an overlaminated PSA construction that involves, inter alia, the steps of: (1) applying a PSA material to a release surface; and (2) applying a

film forming material onto a surface of the PSA material. A key feature of this claim is that all of the recited method steps are carried out during a continuous process.

As discussed above, Samonides fails to disclose or even remotely suggest a PSA construction or method for making the same that involves the step of applying a film-forming material to a surface of a PSA material, yet alone doing this as a part of a continuous process. Also, as noted above, McNaul fails to disclose or suggest any method for making a PSA construction that involves the use of other than preformed elements in the applying steps. Further, McNaul indicates that its final product may be assembled at a location different from and at a time after the different preformed elements are made, e.g., teaching away from the concept of forming a PSA construction using a continuous process. Again, this is consistent with the concept taught in McNaul of assembling a PSA construction using preformed elements.

Now knowing the shortcomings of each cited reference, the combination of the two references is evaluated. Although, as argued by the Examiner, McNaul arguably discloses a PSA construction comprising a film interposed between the PSA layer and a protective overcoating, because it discloses a method of making that involves assembling individual preformed elements, one skilled in the art would not be motivated based on McNaul to derive a continuous process for making a PSA that would involve the use of non-preformed elements. Thus, turning to the combination of Samonides and McNaul, contrary to the Examiner's position, one skilled in the art would not learn and/or be motivated from McNaul to incorporate its film between the PSA material and the protective layer of Samonides using a continuous manufacturing process. Again, it is both inherent and expressed in McNaul that the method of assembling the preformed elements of construction is not done as a continuous process.

Therefore, one having ordinary skill in that art would not find Applicants' invention as recited in claim 46 to be obvious in view of the combination of Samonides and McNaul, as neither provides any motivation to produce a PSA construction according to claimed continuous process. Applicants, therefore, respectfully request that the rejection of independent claim 46, and claims 47, 48 and 50 to 56 depending therefrom, under 35 U.S.C. §103 be reconsidered and withdrawn.

II. Allowed Claims

Applicants acknowledge with appreciation the noted allowance of claims 38 to 42, 45 and 49 and hereby accept the same

III. Request for Telephone Interview with Examiner


Should, after entering this amendment and considering all of the points presented, the Examiner decide to maintain his rejections of the claims based on the two prior art patents discussed above, Applicants respectfully request that the Examiner please contact its attorney or record for the purpose of conducting a telephone interview regarding any such maintained rejection. If possible, Applicants would like to invite the Examiner's supervisor to also participate in any such telephone interview.

IV. Conclusion

Applicants accept the allowance of claims 38 to 42, and claims 45 and 49, and respectfully request that the rejection of the remaining claims under 35 U.S.C. §103 be reconsidered and withdrawn, and that these remaining claims be passed to allowance.

The Commissioner is hereby authorized to charge any additional fees to Deposit Account No. 10-0440, or credit any overpayment to the same.

Respectfully submitted,


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Date: April 16, 2004

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